

**REMARKS**

The Office Action dated September 21, 2005 has been carefully considered. The allowance of claims 17, 18, 20-25, 31-42, 44, and 65-70 is noted with appreciation as is the allowability of claims 11, 12 and 62.

For allowance, claims 11 and 62 are presented herein in independent form. For the reasons set forth hereinafter, the rejections of claims 6-10, 61, 63, and 64 are respectfully traversed, whereby withdrawal of the claim rejections and allowance of the claims is respectfully solicited.

The rejection of claims 6-10, 61 and 63 as being unpatentable under 35 U.S.C. § 103(a) over Niermann '974 in view of Samuelson '238 is again respectfully traversed. In this respect, claim 6 requires that the pair of central ribs of applicants' tape guide extend from the inner end of the bottom of the dispensing arm and terminate at the outer end thereof. To provide Niermann '974 with such ribs as contemplated by the examiner in view of Samuelson '238 would not be a modification of Niermann which would be obvious or suggested to one skilled in the art without knowledge of applicants' disclosure. More particularly in this respect, as is clear from Figures 3 and 16 of Niermann and column 7 of his specification, line 58 to column 8, line 4, arms 80 and 82 and blade support wall 84 which define Niermann's dispensing arm intentionally provide a window 86 through which a user's finger is extended to press tape being dispensed against an underlying surface. To provide Niermann's dispensing arm with ribs extending from the inner to the outer end of the arm, as recited in claim 6, would block the passage of a person's finger through window 86 and would render Niermann's dispenser inoperable for the intended purpose with respect to window 86. As is clearly set forth in MPEP Section 2143.01, if a proposed modification would render a prior art invention unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The examiner's statements that "The ribs of Samuelson extend only a short distance from the blade toward the roll support" (Emphasis added.) and that "Ribs of this length could be placed between the blade and window in the dispensing arm of Niermann" is not tenable in connection with the rejection of claim 6 which states "a pair of central ribs extending from said inner end and terminating at said

outer end." (Emphasis added.) To provide Niermann '974 with short ribs as shown in Samuelson would not meet the latter limitation in claim 6, and to provide Niermann with ribs extending from the inner to the outer end of his arm would block the passage of a person's finger through window 86 of Niermann and, as set forth above, would not be an obvious modification of Niermann.

Further in support of non-obviousness with respect to modifying Niermann '974 to provide a pair of central ribs as recited in claim 6, ribs 22 in Samuelson '238 are not spaced below sides 26 of dispensing arm 20, and the ribs are provided for the sole purpose of mounting cutter blade 18 and a hanger sheet 8 on the dispenser. As is clear from Figures 2 and 4 of Samuelson '238, cutter blade 18 covers ribs 22, whereby the ribs themselves are neither intended to nor capable of providing a tape guiding function. Further in this respect, as is clear from Figure 4 of Samuelson '238 and the description in column 5 from line 46 through line 57, tape is dispensed from roll 11 across the space between tape retaining surfaces 32 and cutting edge 16 of blade 18. It is respectfully submitted, therefore, that the only modification of Niermann '974 which would be obvious or suggested to one skilled in the art in view of Samuelson '238, without improper hindsight reconstruction based on applicants' disclosure would be to provide Niermann with the cutter blade and hanger sheet arrangement of Samuelson, and this modification would not result in a tape dispenser as defined in applicants' claim 6.

For the foregoing reasons, it is respectfully submitted that claim 6 patentably distinguishes from Niermann '974 in view of Samuelson '238, whereby withdrawal of the rejection and allowance of claim 6 is in order and is respectfully requested. The remaining claims rejected, namely claims 7-10, 61, 63, and 64 are all dependent from claim 6 and, therefore, patentably distinguish from the prior art for the same reasons as claim 6 and are allowable. With regard to claim 64, Lin '375 cited thereagainst in combination with Niermann '974 and Samuelson '238 does not overcome the shortcoming of Niermann and Samuelson with respect to claim 6. Accordingly, withdrawal of the rejections and allowance of claims 6-10, 61, 63, and 64 is in order and is respectfully requested.

An earnest effort has been made to place this application in condition for allowance which is respectfully solicited.

**CONCLUSION**

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 6-12, 17, 18, 20-25, 31-42, 44, and 61-70) are now in condition for allowance.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

November 18, 2005  
Date

Thomas E. Young  
Thomas E. Young, Reg. No. 28,924  
1100 Superior Avenue, Seventh Floor  
Cleveland, OH 44114-2579  
216-861-5582

**CERTIFICATE OF MAILING**

Under 37 C.F.R. § 1.8, I certify that this Amendment is being:

- ☒ deposited with the United States Postal Service as First Class mail, addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.
- ☐ transmitted via facsimile in accordance with 37 C.F.R. § 1.8 on the date indicated below.
- ☐ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail Label No.:	Signature <u>Nancy M. Grams</u>
Date November <u>18</u> , 2005	Printed Name Nancy M. Grams

N:\MAEE\200049\US\img0000888V001.doc